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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,254	12/05/2000	Bradley C. Engel	73352-9003-00	8115

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EXAMINER

NAJARIAN, LENA

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,254

Applicant(s)

ENGEL ET AL.

Examiner

Lena Najarian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it exceeds 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-8, 14, 17-20, and 33-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6-8, 14, 17-20, and 33-34 recite the limitations for which there is no antecedent basis in the claims. In particular, the following passages lack or have vague antecedent basis:

(i) "the proposal": claim 6, line 1

claim 7, lines 1 and 2

claim 8, line 1

claim 33, line 1

claim 34, line 2

(ii) "the combined charges": claim 14, lines 1 and 2

(iii) "the principal professionals": claim 14, lines 2 and 3

(iv) "the response reviewing engine": claim 17, line 1

(v) Claims 18-20 incorporate the deficiencies of claim 17, through dependency, and are also rejected.

Claim Rejections - 35 USC § 101

5. Claims 1-24 & 28-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

(A) In the present case, claims 1-14 only recite an abstract idea. The recited steps of exemplary claim 1 of merely establishing contracting healthcare service providers, providing a case statement template, receiving case statement information, preparing a case statement, delivering the case statement, and receiving a response from contracting healthcare service providers does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces responses from healthcare service providers for patients intending to buy a healthcare service. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-14 are deemed to be directed to non-statutory subject matter.

(B) In the present case, it is not clear whether or not the various elements of claims 15-24 clearly and definitely require technology. For example in exemplary claim 15, a database in its broadest sense, may simply be a paper-based table (e.g., chart) or paper files in a file cabinet. In a similar manner, a "construction engine" and a "response-receiving engine" may broadly include a template having fields for "quality indicator areas" and/or a mailbox by which paper responses are received and/or delivered. As such, the claims when given their broadest reasonable interpretation appear to be devoid of any technological device.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces responses from healthcare service providers for patients intending to buy a healthcare service. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 15-24 are deemed to be directed to non-statutory subject matter.

(C) Moreover, in the present case, claims 28-34 only recite an abstract idea. The recited steps of exemplary claim 28 of merely establishing contracting healthcare service providers, providing a case statement template, extracting case statement information, preparing a case statement, making the case statement available to specific contracting healthcare service providers, and receiving a response to the case statement from a contracting healthcare service provider does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces responses from healthcare service providers for patients intending to buy a healthcare service. Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 28-34 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 6-17, 22-29, and 33-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Henley.

(A) Referring to claim 1, Henley shows a method of selling medical services to a patient, the method comprising (see paragraph 29, lines 9-14 of Henley):

establishing a plurality of registered providers of medical services (paragraph 104, lines 6-9 of Henley);

providing a registration form having one or more areas to specify clinical and non-clinical requirements of the patient (paragraph 120, lines 1-10 and paragraph 108, lines 3-11 of Henley);

receiving registration information, at least a portion of which is provided by the patient (paragraph 120, lines 1-10 of Henley);

preparing a registration post based on the registration information (paragraph 120, lines 15-17 of Henley);

providing the registration information to at least one registered provider of medical services (paragraph 120, lines 15-17 of Henley); and receiving a response from the at least one registered provider of medical services, the response including a price, a clinical track record, and service information (paragraph 90, lines 6-12, paragraph 91, lines 7-12 and paragraph 23, lines 5-8 of Henley).

(B) Referring to claim 2, Henley discloses wherein the response includes information concerning one or more quality indicators for one registered provider of medical services (paragraph 90, lines 6-12 of Henley).

(C) Referring to claim 6, Henley discloses reviewing the response from the at least one registered provider of medical services (paragraph 87, lines 1-2 and paragraph 98, lines 1-3 of Henley).

(D) Referring to claim 7, Henley discloses reviewing the response from the at least one registered provider of medical services includes reviewing the response with a physician (paragraph 136, lines 4-14 of Henley).

(E) Referring to claim 8, Henley discloses that the response includes information concerning the total cost of a medical procedure (paragraph 86, lines 4-9 and paragraph 23, lines 5-8 of Henley).

(F) Referring to claim 9, Henley discloses securing the services of a responding medical services provider by sending a deposit to the responding medical services provider (paragraph 117, lines 10-12 of Henley).

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(G) Referring to claim 10, Henley discloses securing the services of a responding medical services provider by sending a deposit to a transaction system operator and sending a remaining amount to the responding medical services provider (paragraph 88, lines 1-5 of Henley; the Examiner interprets the “deposit” to be a form of “billed for system use”).

(H) Referring to claim 11, Henley shows that preparing registration information includes accessing a qualifier database that stores the identification of medical service providers having satisfied a particular qualifying requirement (paragraph 94, lines 6-10 of Henley).

(I) Referring to claim 12, Henley discloses scheduling an outpatient visit with the patient and a staff member of the at least one registered medical services provider (paragraph 44, figure 1, item 14 and paragraph 75 of Henley).

(J) Referring to claim 13, Henley discloses the price is a not-to-exceed amount (paragraph 29, lines 1-4 of Henley; the Examiner interprets the “not-to-exceed” amount to be equivalent to a “fixed price”).

(K) Referring to claim 14, Henley discloses the price includes the combined charges of a facility of the at least one registered medical services provider and the principal professionals performing the medical services (paragraph 112, lines 1-11 of Henley).

(L) Referring to claim 15, Henley discloses a system of selling medical services, the system comprising (see paragraph 104 of Henley):

a database of registered medical services providers (figure 11, item 207 and paragraph 121, lines 9-17 of Henley);

a medical registration request form including areas for a patient's clinical and non-clinical requirements (paragraph 120, lines 1-10 and 15-17);

a medical posting database to deliver request forms to medical service providers (paragraph 120, lines 15-17 of Henley);

a proposal construction engine (paragraph 40, lines 3-7 of Henley) including quality assurance data (paragraph 90, lines 6-12 of Henley); and

a response-receiving engine to receive responses from medical service providers and to deliver the responses to the patient (paragraph 65 of Henley).

(M) Referring to claim 16, Henley discloses a database of patients/buyers (figure 9, item 75 and paragraph 104, lines 6-9 of Henley).

(N) Referring to claim 17, Henley teaches a mechanism that allows users to check responses for quality of the services to be provided (paragraph 19, lines 8-13 of Henley).

(O) Referring to claim 22, Henley discloses a feedback mechanism including a number of input mechanisms to construct a message (figure 18 and paragraph 134 of Henley).

(P) Referring to claim 23, Henley shows a mechanism that checks responses for a price of healthcare services listed (paragraph 19, lines 8-13 of Henley).

(Q) Referring to claim 24, Henley discloses a billing processing unit (paragraph 98, lines 17-19 of Henley).

(R) Referring to claim 25, Henley discloses at least one patient terminal coupled to the registration information submission mechanism (paragraph 105, lines 7-17 and figure 9, item 90 of Henley).

(S) Referring to claim 26, Henley discloses at least one service provider terminal coupled to the medical services information distribution engine (paragraph 52 and figure 9, items 90 and 82).

(T) Referring to claim 27, Henley discloses that the registration submission mechanism; the registration distribution engine; the proposal construction engine; and the response-receiving engine are located on a server (paragraph 32, lines 1-8, paragraph 83, lines 1-5 and figure 7 of Henley).

(U) Referring to claim 28, Henley discloses a method of selling medical services to a patient, the method comprising (see paragraph 29, lines 9-14 of Henley):

- establishing a plurality of registered providers of medical services (paragraph 104, lines 6-9 of Henley);

- providing a registration form having one or more areas to specify clinical and non-clinical requirements of the patient (paragraph 120, lines 1-10 and paragraph 108, lines 3-11 of Henley);

- extracting registration information, at least a portion of which is provided by the patient, from the registration form (paragraph 120, lines 4-17 of Henley);

- establishing registration information criteria for each of the plurality of registered medical service providers (paragraph 120, lines 1-10 of Henley);

- making the registration information available to each registered medical service provider whose criteria matches the registration information (paragraph 104, lines 6-9 and 13-16 of Henley); and

receiving a response to the registration post from the at least one registered provider of medical services, the response including a price, a clinical track record, and non-clinical information (paragraph 90, lines 6-12, paragraph 91, lines 7-12 and paragraph 23, lines 5-8 of Henley).

(V) Claim 29 repeats the same limitations of claim 2, and therefore is rejected for the same reasons given for that claim.

(W) Claims 33-34 repeat the same limitations of claims 6-7, and are therefore rejected for the same reasons given for those claims.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4-5, 19-21, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley (US 2002/0065758) as applied to claims 1-2, 15-17, and 28-29 above, and further in view of Tawil (5,519,607).

(A) Referring to claims 4 and 5, Henley does not show that the one or more clinical quality indicators includes the number of times a medical procedure has been performed and the number of times a medical procedure has been performed by a

physician associated with one of the one or more registered providers of medical services.

Tawil discloses a database with background information concerning each provider (column 3, lines 9-10 of Tawil), including the number of times the provider has performed the procedure (column 3, lines 16-23 of Tawil). Tawil also discloses that when claims are processed, the number of times the procedure has been performed can be updated (column 3, lines 18-22).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Henley's method to include additional information on the background of the procedure, such as the number of times the procedure has been performed. The motivation for doing so would have been to provide patients with information to assist their decision making process and to allow them to determine the quality of the services to be provided (column 4, lines 55-57 and 64-67 of Tawil).

(B) Claims 19-20 and claims 31-32 repeat the same limitations of claims 4-5, and are therefore rejected for the same reasons given for those claims.

(C) Referring to claim 21, Henley does not disclose a referring physician template.

Tawil discloses a list of providers (column 1, lines 48-55; the Examiner interprets "list" to be a form of "referring template").

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Tawil within Henley. The motivation for doing so would have been for additional background information in the system (column 1, lines 48-52 of Tawil).

10. Claims 3, 18, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henley (US 2002/0065758) in view of Tawil (5,519,607) as applied to claims 1-2, 15-17, and 28-29 above, and further in view of Papageorge (US 6,584,445 B2).

(A) Referring to claim 3, Henley and Tawil do not disclose that the one or more clinical quality indicators include the mortality rate for a medical procedure.

Papageorge discloses that the users receive data, such as morbidity and mortality rates for each treatment (column 7, lines 25-29 of Papageorge).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the feature of Papageorge within Henley and Tawil. The motivation for doing so would have been to provide the users with information on the risks of each treatment option (column 7, lines 41-44 of Papageorge).

(B) Claims 18 and 30 repeat the same limitations of claim 3, and are therefore rejected for the same reasons given for that claim.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teaches a computer-implemented method for determining an optimal award schedule (US-2003/0004850 A1); a method, system and computer site for conducting an online auction (US-2003/0093355 A1); a system for providing medical information (US-5,918,208 A); a website that allows patients to bid for surgery (medicineonline.com/bidforsurgery); and a

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a method and system for generating statistically-based medical provider utilization profiles (US-5,557,514 A).


Also included are three provisional applications (60/186,542; 60/201,021; and 60/222,648), which are priority documents to applied reference, US-2002/0065758 A1 (Henley).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lena Najarian whose telephone number is (703) 305-0260. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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